

Notice of Allowability

Application No.

09/922,842

Examiner

Callie E. Shosho

Applicant(s)

YAMANOUCI ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 3/15/04 and telephonic interview conducted 6/1/04.
2. ☒ The allowed claim(s) is/are 25-45 and 47-52.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 6/1/04.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Callie E. Shosho
Primary Examiner
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Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) Claim 30, line 8, after "dispersion" and before ".", insert "wherein an ink is produced".

(2) Claim 40, line 8, after "dispersion" and before ",", insert "wherein an ink is produced".

(3) Claim 42, line 8, after "dispersion" and before ",", insert "wherein an ink is produced".

(4) Claim 43, line 8, after "dispersion" and before ",", insert "wherein an ink is produced".

(5) Claim 45, line 8, after "dispersion" and before ",", insert "wherein an ink is produced".

2. Authorization for this examiner's amendment was given in a telephone interview with Roger Lee on 6/1/04.

Statement of Reasons for Allowance

3. In the office action mailed 11/14/03, claims 25-27, 30-39, and 46-52 were rejected by Mizukawa et al. (U.S. 2002/0017217) while claims 28-29 and 40-45 were indicated as objected to as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

In response, in the amendment filed 3/15/04, applicants have rewritten claims 28-29, 40, 42-43, and 45 in independent form as described above (it is noted that claims 41 and 44 depend from claims 40 and 43, respectively). Claim 46 was cancelled.

With respect to claims 25-27, 30-39, and 47-52, it is noted that Mizukawa et al. disclose method for producing ink wherein the method comprises first step of preparing dye solution having oil-soluble dye dissolved in organic solvent and then mixing this dye solution with water to prepare dispersion of the dye particulates, second step of preparing an oil-soluble polymer solution having the oil-soluble polymer dissolved in an organic solvent and then mixing the oil-soluble polymer solution with water to prepare dispersion of the oil-soluble polymer particulates, and third step of mixing the dispersion of dye particulates with the dispersion of oil-soluble polymer particulates to prepare coloring particulates.

However, the filing date of Mizukawa et al. lies between the filing date and the priority date of the present application as seen below:

Application No. 09/922,842 *priority date* – 8/7/00

Mizukawa et al. *filing date* – 3/8/01

Application No. 09/922,842 *filing date* – 8/7/01

Under MPEP 706.02(b), rejections based on 35 U.S.C. 102(e) can be overcome by perfecting the filing date of the priority document. Applicant's submission of certified priority document on 10/31/01 and its English language translation on 3/15/04 results in the perfection of the foreign priority filing date. Thus, Mizukawa et al. is no longer applicable against claims 25-27, 30-39, and 47-52.

In light of the above, the rejections and objections of record are untenable and so, claims 25-45 and 47-52 are passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
6/1/04